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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,643	10/05/2001	Yoichi Ozawa	210090US0PCT	4356

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

PADEN, CAROLYN A

ART UNIT	PAPER NUMBER
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1761

17

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/868,643

Applicant(s)

OZAWA ET AL.

Examiner

Carolyn A Paden

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-10, 13 and 15-47 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 11, 12 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-8, 13, 15-19 and 29-32 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 20-28, 33 and 39-47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Applicant called to note that the examiner prosecuted the wrong claim in Paper 15. Accordingly the rejection of the claims set forth in this paper has been withdrawn. The restriction requirement against the claims is maintained for the reasons set forth in Paper 15.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,952,230) in view of Bartesch (4,556,573) Christianson (4,495,207).

Kim discloses a mechanical method for separating soybean embryos from the rest of the soybean. The final product is stated to contain 30-70% embryos. Applicant draws equivalence between soybean germ and soybean embryo in the difference in the title utilized in paper 14 and paper 7. The claims appear to differ from the reference in the suggestion of extracting oil from soybean germ. Extraction of edible oil from seeds is a well-known expedient as shown by the wide variety of seed oils that are presently on the market. Bartesch teaches that it is well known in the art to

extract edible oil from soybean meal. The extraction of oil from corn seed germ is also well known in the art, as shown by Christianson (4,495,207).

Thus with the references before him, it would have been obvious to one having ordinary skill in the art to utilize soybean germ as a starting material to obtain an oil source.

Claims 7, 10 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,952,230) in view of Bartsch (4,556,573) Christianson (4,495,207) as applied to claims 4-6 above, and further in view of Tokue "Properties" article.

The claims appear to differ from the reference in the suggestion that the soybeans contain a particular level of sterols and also a particular level of tocopherol. Tokue shows that the content of soybean embryo lipids inherently possesses the sterol content and the tocopherol content of the claims at Tables 7 and 8.

Claims 7, 8, 13-19, 31, 32 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,952,230) in view of Bartsch (4,556,573) Christianson (4,495,207) as applied to claims 4-6 above, and further in view of Tokue "Properties" article as applied to claims 4-6 above, and further in view of Menshitsu ("Sterol Composition" article).

The claims appear to differ from the reference in the indication of the campesterol content, which Menshitsu shows to be an inherent part of the composition that contains soybean embryo. Thus with the teachings of Menshitsu, one of ordinary skill in the art would expect that the soybean embryo oil would contain the campesterol content of the claims and also expect that the tocopherol content of the oil to be within the range that is set forth in the claims.

The claims also appear to differ from the reference in the suggestion of the method by which the product is made. To extract oil from soybeans by one method or the other is not alone seen to constitute unobviousness. Also to use an edible oil in food would have been an obvious to use it for its nutritive values.

Claims 9, 10, 20-28, 33 and 39-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the reference show a soybean oil with the particular phytosterol content that is set forth in the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone

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number is 703-308-3294. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

if attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (703) 308-3959.

The fax phone number for the organization where this application or proceeding is assigned is 703-305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


CAROLYN PADEN 8-4-03
PRIMARY EXAMINER
GROUP 1300-1761